

REMARKS/ARGUMENT

Claims 3 and 5-18 have been amended and claims 19-43 have been added. Claims 1-43 are pending in the Application. The application has been carefully reviewed in light of the Office Action mailed on October 24, 2003. Reconsideration of all outstanding rejections in light of the foregoing amendments and following remarks is respectfully requested.

Claims 3 and 5, 7-8 and 10-18 have been amended to correct antecedent basis language. For example, claim 3 has been amended to recite, *inter alia*, “[a] method of answering an incoming call at a cordless telephone comprising the steps of: a first party answering the incoming call at ~~the~~ a base unit of the cordless telephone, ~~the~~ a handset being at a location separate from ~~a~~ the base unit of the cordless telephone” Claims 6 and 9 have been amended to insert “and” between two claim elements. Accordingly, no new matter or change in claim scope has been introduced by these amendments.

Claims 12, 15 and 17 have been amended to more clearly state the claimed subject matter. For example, claim 12 has been amended to recite, *inter alia*, “A cordless telephone system comprising: a base station including first control circuitry for controlling operations at said base station and separate intercom buttons for each of a plurality of cordless telephone handsets ~~handset~~; said plurality of cordless telephone handsets comprising at least a first and second cordless telephone handsets” Claim 15 has been amended to recite, *inter alia*, “A ... base station comprising ... an intercom initiator ... wherein when an intercom initiation signal is received from a handset during an active call ... wherein when said intercom initiator is activated during ~~an~~ said active call, said active call is placed on hold and ~~an~~ said intercom communication is initiated with said handset.” Claim 17 has been amended to recite, *inter alia*, “A cordless telephone handset comprising ... an intercom initiator ... wherein when said intercom initiator is activated during an active call, said active call is placed on hold and an intercom communication is initiated with at least a base station; ... wherein when an intercom initiation signal is received during

~~an~~ said active call, said active call is placed on hold and ~~an~~ said intercom communication is initiated.”

The invention is directed to cordless telephone methods and systems which, among other things, place an active call on hold during intercom communications. For example, the method of claim 1 recite, *inter alia*, “a first party answering the incoming call ... the first party alerting a second party, by initiating an intercom connection ... while the incoming call is automatically placed in hold status [and] ... the second party accepting the incoming call at the base unit by terminating the hold status”, as in claim 1. As another example, amended claim 12 recites, *inter alia*, “a cordless telephone system comprising ... a base station including first control circuitry ... a plurality of cordless telephone handsets ... including second and third control circuitry ... said first, second and third control circuitry operating in response to initiation of an intercom communication at one of said base station and said first and second handsets to place an active call on hold during said intercom communication.”

Claims 1-4, 6-8 and 15-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada (U.S. Patent No. 4,650,931). Reconsideration is respectfully requested.

The Office Action mischaracterizes Tsukada as disclosing “a first party answering the incoming call [Tsukada at COL. 2, lines 42-53] ... the first party alerting a second party, by initiating an intercom connection ... while the incoming call is automatically placed in hold status [COL. 3, lines 8-16; COL. 8, lines 51-58] ... and the second party accepting the incoming call at the base unit by terminating the hold status” (COL. 8, lines 28-34 and 38-50), as in claim 1.

The first section of Tsukada at COL. 2, lines 42-53, cited by the Office Action discloses “a cordless telephone in which either one of the handset and base units may receive an incoming telephone call which appears when the telephone is in the *intercom mode*” and “... a cordless telephone in which, if an incoming call appears when the

telephone is in the intercom mode ..., either of the handset and base units may be actuated to withdraw from the intercom mode and automatically connect to the other of the units with the telephone line to receive the incoming telephone call.” As shown above, the cited section of Tsukada only discloses “reciev[ing] an incoming call which appears when the telephone is in the intercom mode” and “if an incoming call appears when telephone is in the intercom mode” (emphasis added) There is no disclosure in this cited section of Tsukada of, *inter alia*, “a first party *answering the incoming call* ...[and] the first party ... *initiating an intercom connection*” There is only disclosure in the sections of Tsukada cited above of receiving an incoming call during the intercom mode.

The next section cited by the Office Action in support of its rejection of claim 1 is at COL. 3, lines 8-16, which states “[t]he telephone has a telephone mode of operation wherein the ... base unit or the handset unit is in communication with the telephone network, and an intercom mode ... wherein the base and handset ... are in communication with each other, and means for selectively establishing the telephone in one of the telephone and intercom modes” (emphasis added) The telephone mode presumably would be in effect if a “a first party answ[ered] the incoming call ...” as in claim 1. Again, the sections of Tsukada cited above only disclose receiving an incoming call during the intercom mode, not “*answering the incoming call* ...[and] ... *initiating an intercom connection*”, as in claim 1.

Lastly, Tsukada at COL. 8, lines 51-58 states “[t]he cordless telephone may also be operated in the intercom mode, wherein the handset ... is in communication with auxiliary telephone 4 ... through connecting circuit 230. In the intercom mode, the hold relay within relay circuit 232 reserves the incoming telephone call appearing on telephone network line 3a.” (emphasis added) Again, the cited sections of Tsukada do not disclose, *inter alia*, “a first party *answering the incoming call* ... [and] the first party ... *initiating an intercom connection*” Tsukada here only discloses receiving an incoming call during the intercom mode.

Further, Tsukada at COL. 12, lines 64 - 68 states “[t]he operation of cordless telephone 10 ... in establishing the intercom mode ... assume[s] that cordless telephone 10 as previously in a standby condition, and there is no incoming telephone call. If the handset operator wishes to initiate intercom mode ... , he moves talk switch 152 to its TALK position and then depresses intercom key 153.” (emphasis added) Thus, a handset must have its talk switch 152 moved to the TALK position from the standby condition to initiate the intercom function. Consequently, Tsukada at COL. 12, lines 64 to 68 excludes the possibility that the handset switch was already in the talk position, which is required for, *inter alia*, “*answering the incoming call ...[and] initiating an intercom connection ...*” as in claim 1.

The Office Action also incorrectly states that Tsukada discloses, *inter alia*, “ ... the second party accepting the incoming call at the base unit by terminating the hold status” (on page 2 of the Office Action citing Tsukada at COL. 8, lines 28-34 and 38-50). These cited sections state “[i]n the telephone mode, hold relay 232 releases the incoming telephone call and either the ... base unit 2A, that is auxiliary telephone 4, or the ... handset unit 1A ... is placed in communication with telephone line 3a. The connection between the ... handset unit ... and the telephone network line 3a is accomplished through ... handset unit 1A [and] ... base unit 2A In such case, handset unit 1A is in communication with base unit 2A ... [and therefore] the telephone line 3a.” (emphasis added)

COL. 8, lines 28-34 and 38-50 of Tsukada does not disclose the inventive combination of “a first party answering the incoming call ... the first party alerting a second party, by initiating an intercom connection ... while the incoming call is automatically placed in hold status [and] ... the second party accepting the incoming call at the base unit by terminating the hold status” as recited in claim 1. Tsukada, COL. 8, lines 28-34 and 38-50 only discloses the initial connection of an incoming telephone call without reference “terminating” a “hold status”, much less whether a party at the base unit or the handset unit is performing the act of “accepting the incoming call”.

In fact, Tsukada at COL. 6, lines 18-24 and 25-28 states that the “hold relay” 232 has two positions: “first position [that] can hold a connection with telephone network line 3a while disconnecting it from hybrid circuit 231 ... so that telephone communication with telephone network line 3a is temporarily interrupted during an intercom operation ... [and] a second position in which telephone network line 3a is made available for connection to hybrid circuit 231...” (i.e., hold during intercom mode or connection to telephone line in telephone mode). Accordingly, there is no disclosure in the sections of Tsukada cited by the Office Action of “the second party accepting the incoming call at the base unit by terminating the hold status”.

Accordingly, claim 1 is allowable over Tsukada for at least the above reasons. Claim 2 and new claims 19-23 are allowable along with claim 1, and for other reasons.

Claim 3 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada. Reconsideration is respectfully requested.

Tsukada does not disclose, *inter alia*, “answering the incoming call ... [and] initiating an intercom connection” As shown above in the discussion of claim 1, Tsukada’s system does not place a telephone line on hold unless an intercom session is already in progress; thus, claim 3 is allowable over Tsukada. Claim 4 and new claims 24-27 depend from claim 3, and are allowable along with claim 3.

Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada. Reconsideration is respectfully requested.

Tsukada does not disclose, *inter alia*, “first and second control circuitry operating in response to initiation of an intercom communication ... to place an active call ... on hold during said intercom communication” as in claim 6. Tsukada’s system does not place a telephone line on hold unless an intercom session is already in progress as explained in connection with claim 1, thus claim 6 is allowable over Tsukada. Claims 7 and 8 depend from claim 6 and are allowable along with claim 6.

Claim 15 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada. Reconsideration is respectfully requested.

Tsukada does not disclose, *inter alia*, “ ... wherein when an intercom initiation signal is received from a handset during an active call, said active call is placed on hold and an intercom communication is initiated....” as in claim 15. As discussed above with respect to claim 1, Tsukada’s system does not place a telephone line on hold unless an intercom session is already in progress; thus, claim 15 is allowable over Tsukada. Claim 16 depends from claim 15 and is allowable along with claim 15.

Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada. Reconsideration is respectfully requested.

Tsukada does not disclose, *inter alia*, “ ... during an active call ... said active call is placed on hold and an intercom communication is initiated”, as recited in claim 17. As discussed in connection with claim 1 above, Tsukada’s system does not attempt to place a telephone line on hold unless an intercom session is already in progress, thus amended claim 17 is allowable over Tsukada. Claim 18 depends from claim 17 and is allowable along with claim 17.

Claims 5 and 9-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsukada further in view of Kunihiro (U.S. Patent No. 5,014,295). Reconsideration is respectfully requested.

Amended claim 5 is erroneously rejected under 35 U.S.C. § 103(a) over Tsukada and Kunihiro. Tsukada does not disclose a method of answering an incoming call comprising “... answering the incoming call ... [and] initiating an intercom connection ... while the incoming call is automatically placed in a hold status” Again, Tsukada does not place an active call on hold during said intercom communication as discussed above with respect to claim 1.

The Office Action cites Kunihiro at FIG. 7A, label t1, COL. 7, lines 1-4 and COL. 8, lines 30-34 as disclosing “... answering the incoming call” However, an examination of Kunihiro’s FIG. 7A, “label t1” reveals that point t1 is merely a time point where processing begins after an incoming call is detected by Kunihiro’s system. While the continuation to FIG. 7A, FIG. 7B, does disclose “depress talk key” and “communicate with incoming call”; there is no disclosure of the combination of “... answering the incoming call [and] initiating an intercom connection ...”, as in claim 5.

Also, there is no explanation in the Office Action how the mere act of “communicating with incoming call” in FIG. 7B is related to the other sections of Kunihiro that the Office Action claims discloses the remainder of the missing limitations of claim 5. In reference to FIG. 7A, Kunihiro discloses that “[t]he manner in which an incoming call is received from a telephone line and extended to a remote handset unit will now be described in conjunction with ... FIGS. 7A” (COL. 12, lines 45-48) Nowhere in FIG. 7A, or its continuation figure, FIG. 7B, is “... answering the incoming call ... [and] initiating an intercom connection ...” disclosed. Moreover, neither Kunihiro’s FIG. 7A, FIG. 7B or accompanying text disclose “... initiating an intercom connection while the incoming call is automatically placed in a hold status”

The Office Action cites COL. 7, lines 1-4 and COL. 8, lines 30-34 as disclosing claim 5’s “initiating an intercom connection” Kunihiro, COL. 6, lines 66 to COL. 7, line 4, states “[f]unction control keys [of the handset unit] ... carry out various operations, such as to establish an intercom connection, to place a telephone call on “hold”, to redial the last dialed telephone number, to dial predetermined telephone numbers, and the like.” Nowhere in COL. 7, lines 1-4 is “... answering the incoming call ... [and] initiating an intercom connection ...” disclosed. Instead, Kunihiro discloses that only one of the listed operations in COL. 7, lines 1-4 may be carried out at a time, not in combination.

The remaining section cited by the Office Action (i.e., COL. 8, lines 30-34 of Kunihiro), discloses “the switch circuit functions to connect base unit 21A to any one of the base units 21B and 21D to permit an intercom-type communication between two

handset units.” Again, nowhere in COL. 8, lines 30-34, is “ ... answering the incoming call ... [and] initiating an intercom connection ...” disclosed.

In fact, Kunihiro’s intercom mode only discloses initiating an intercom mode when both base station and handset unit called to initiate an intercom connection are “available”. Kunihiro at COL. 20, line 65-66, states “[a]ny two available handset units may communicate with each other in so-called intercom mode.” Kunihiro then continues explaining its example of use of the intercom mode stating “ ... assum[ing] that handset unit 1A is ... in its standby mode and that an intercom key is operated” (emphasis added). Kunihiro discusses system availability of both base station(s) and contacted handset for intercom mode communications at COL. 20, line 65 through COL. 21, line 64, as being in standby modes only. Kunihiro at COL. 21, lines 13-15 and 17-18 continues stating “[a]ssuming that base unit 21A is available and, thus, is selected ... to communicate with handset unit 1A ... the base station detects that intercom communication is requested ...” Moreover, Kunihiro at COL. 21, lines 51-58, states “at the completion of ... a conversation, if the talk key at either of the handset units ... is operated, communication between that handset unit and the base unit to which it is connected terminates similar to the manner in which an outgoing telephone call is terminated when the talk key at the handset unit is operated.”

In addition, Kunihiro’s system does not disclose, *inter alia*, “initiating an intercom connection ... while the incoming call is automatically placed in a hold status ...” as in claim 5. There is no discussion in Kunihiro of placing an incoming call in a hold status in either the section of Kunihiro discussing processing of incoming calls (COL. 12, line 45 to COL. 20, line 64) or Kunihiro’s discussion of its intercom mode (COL. 20, line 65 to COL. 21, line 65)

Accordingly, even if both Tsukada and Kunihiro were combined, they would not disclose at least “ ... answering the incoming call ... [and] initiating an intercom connection ...” or “initiating an intercom connection ... while the incoming call is automatically placed in a hold status” as in claim 5. In view of at least the above, claim

5 is allowable over both Tsukada and Kunihiro. New claims 28-29 depend from claim 5 and are allowable along with claim 5.

Claims 9 and 12 are also erroneously rejected under 35 U.S.C. § 103(a) over Tsukada and in view of Kunihiro. Tsukada does not disclose, *inter alia*, “ ... first, second and third control circuitry operating in response to initiation of an intercom communication ... to place an active call on hold during said intercom communication”, as recited in amended claims 9 and 12. As discussed above, neither Tsukada nor Kunihiro discloses “... plac[ing] an active call on hold during said intercom communication ...” as in amended claims 9 or 12.

Claim 12 is further distinguished over both Tsukada and Kunihiro in that neither reference discloses “a base station including ... separate intercom buttons for each handset.” FIG. 1 of Tsukada does not disclose “intercom buttons” on base station 2. FIG. 1 of Kunihiro does not disclose “separate intercom buttons for each handset.” as in claim 12.

Accordingly, claims 9 and 12 are allowable over both Tsukada and Kunihiro. Claims 10-11 depends from claim 9 and claims 13-14 depend from claim 12 and are allowable along with claims 9 and 12.

New independent claims 30 and 39 are also allowable over both Tsukada and Kunihiro. Claims 30 and 39 both recite a “ ... said active call is placed on hold and an intercom communication is requested.” As discussed above, Tsukada does not place an active call on hold to request an intercom communication and Kunihiro only performs a telephone call or an intercom session, not a combination thereof. Accordingly, claims 30 and 39 are both allowable over the art of record. Claims 31-38 depend from claim 30 and are allowable along with claim 30. Claims 40-43 depend from claim 39, and are allowable along with claim 39.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: February 11, 2004

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